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REMARKS

Claims 1-27 are currently pending in the above-identified patent application. In the subject Office Action, the Examiner stated that in claims 1, 4-6, 9-10, 13-15, 18, 22-24, and 27 the limitation "adapted to" is not considered as a positive limitation since it has been held that the recitation that an element is "adapted to" perform only requires the ability to so perform and it does not limit a claim to a particular structure and it does not limit the scope of a claim or claim limitation. Applicants wish to thank the Examiner for having identified this difficulty, and have amended claims 1, 4-6, 9-10, 13-15, 18, 22-24, and 27 to correct this problem. No new matter has been added as a result of these changes.

Applicants wish to direct the Examiner's attention to the matter that in the subject patent application, as originally filed, there were 27 not 26 claims, since there were 2 claims identified as claim 25. Applicants have amended the second claim 25 to be claim 26 and original claim 26 to be claim 27. No new matter has been added by these changes. Applicants have also paid for an additional dependent claim in accordance with the requirements of the U.S. Patent and Trademark Office.

Claims 1, 3-10, 12-19 and 21-27 were rejected under 35 U.S.C. 102(b) as being anticipated by Verdun (U.S. Patent No. 5,805,833), since regarding claims 1, 10 and 19, the Examiner stated that Verdun discloses in FIGURE 3 a switchable probe board (unit interface 150) for probing a parallel bus (165) comprising: a connector (65) adapted to connect into said parallel bus (165); a plurality of signal paths (pin connectors 255 in FIGURE 4) corresponding to individual signals of said parallel bus (165), each of said plurality of signal paths (255) having a passive filter, and an adjustable filter circuit, said plurality of signal paths (255) being electrically communicated to said connector (65); a switch matrix (85) connected to each of said plurality of signal paths (255) and having at least one output; and a controller (computer system 15 in FIG. 2) adapted to configure said switch matrix (85) to connect one of said plurality of signal paths (255) to said at least one output, said controller (15) having an input; wherein said switchable probe board (150) is a single printed circuit board.

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Applicants respectfully disagree with the Examiner concerning the rejection of independent claims 1, 10 and 19 as being anticipated by Verdun for the reasons to be set forth hereinbelow.

The Examiner continued by rejecting dependent claims 3-9, 12-18, and 21-27 as also being anticipated by Verdun. Since claims 3-9, 12-18, and 21-27 depend from independent claims 1, 10 and 19, respectively, and applicants believe that these independent claims are patentable over Verdun, applicants believe that the narrower dependent claims are patentable over Verdun, and that no further response is necessary with regard to these claims.

Claims 2, 11 and 20 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Turning now to the Verdun reference, applicants wish to point out that in Col. 5, lines 1-6 it is stated that: "The overall expansion unit interface 150 is split into a system side 155 and an expansion option side 160. System side 155 contains all the portable computer 15 subsystems that communication and interface with peripherals such as 110, 125, 120, 117 and 115." Further, in Col. 5, lines 41-46 of Verdun it is stated that: "Turning to FIG. 4, a block diagram depicting the expansion option interface 250 is shown. The physical connection 85 to the system side 155 comprises a plurality of pin conductors 255 forming a signal pathway between portable computer system 15 components and device peripherals 275, 280, 330, 335 and 380." See also FIG. 2 of Verdun.

Taking subject claim 1 as an example, subject independent claims 1, 10 and 19 recite that the "... switchable probe board for probing a parallel bus comprising ... a plurality of signal paths corresponding to individual signals of said parallel bus, each of said plurality of signal paths having a passive filter, and an adjustable filter circuit, ... a switch matrix connected to each of said plurality of signal paths and having at least one output; and a controller adapted to configure said switch matrix to connect one of said plurality of signal paths to said at least one output"

Clearly, Verdun teaches that computer 15 is located on the system side of FIGURE 3, not on a switchable probe board, as recited in subject claim 1.

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Moreover, it is the plurality of pin conductors 255 of Verdun which form the signal pathway between portable computer system 15 components and the device peripherals, as opposed to a switch matrix connected to each of said plurality of signal paths as is recited in subject claim 1. Further, there is no teaching in Verdun of "... each of said plurality of signal paths having a passive filter, and an adjustable filter circuit .. ." as is also recited in subject claim 1.

Similar arguments may be made for subject claims 10 and 19.

Thus, applicants believe that Verdun teaches away from the present claimed invention, rather than anticipating it.

In view of the discussion presented hereinabove, applicants believe that subject claims 1-27, are in condition for allowance, and such action by the Examiner at an early is earnestly solicited.

Reexamination and reconsideration are respectfully requested.

Respectfully submitted,

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